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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,860	12/09/2003	Robert F. Rosenbluth	388700-001BC	3526
37374	7590	12/11/2008	EXAMINER	
INSKEEP INTELLECTUAL PROPERTY GROUP, INC			NGUYEN, VI X	
2281 W. 190TH STREET				
SUITE 200			ART UNIT	PAPER NUMBER
TORRANCE, CA 90504			3734	
			NOTIFICATION DATE	DELIVERY MODE
			12/11/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

inskeepstaff@inskeeplaw.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/730,860	ROSENBLUTH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor X. Nguyen	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 October 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 33,34,51-53 and 62-64 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 33,34,51-53 and 62-64 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. The request filed on 10/9/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/730,860 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-34,51-53 and 62-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification (submitted on 12/9/2003) in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 33, the disclosure does not describe "a plurality of resilient members having proximal ends freely slidable over said inner tube". Clarification is requested.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33,34,51,53 and 62-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Ressemann et al (5,540,707).

Ressemann et al disclose in figures 14 and 17, an embolus removal apparatus 16 disposed on an inner tube 94 where the removal device is initially disposed in a collapsed configuration and constrained in the collapsed configuration by a portion of the outer tube 188, where an embolectomy catheter is advanceable over a guidewire 42, and where the embolus removal apparatus is configured to expand automatically from the collapsed configuration to a deployed configuration upon the axial retraction of the outer tube (fig. 17), where the embolus removal apparatus comprises a plurality of helical resilient wires 102 having proximal ends which is inherently freely slidable over the inner tube, and where the distal ends fixed to the inner tube, and where the resilient wires are attached to a collar 322 which is slidably mounted on the inner tube.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ressemann, et al-707 in view of Cohen, et al-5167239.

Ressemann, et al disclose the invention as claimed with the exception of a plurality of infusion ports. However, Cohen discloses that infusion ports (figures 2, 5) were known at the time of the invention. Therefore, it would have been obvious to have provided Ressemann with infusion ports as this would allow the ports to be used to infuse medications during use.

***Response to Arguments***

5. Applicant's arguments filed 08/13/2008 have been fully considered but they are not persuasive.

The applicant argues that Ressemann et al reference fails to show certain feature of applicant's invention, it is noted that the feature upon which applicant relies (i.e., *the removal element is housed within an outer tube*) is not recited **in the rejected claim(s)**

33. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In fact, there is nothing in Ressemann's reference could prevent the removal element 16 can be folded on to itself underneath the catheter shaft 188 by a distal axial movement of the catheter shaft 188 (in a direction with pointed arrow in fig. 17), where the removal element disposed on an inner tube 94.

Applicant's argument with regard to that Ressemann fails to teach an embolus removal apparatus wherein the outer tube is axially retractable to remove the constraint on the embolus removal apparatus such that the removal apparatus automatically expands from the collapsed configuration to a deployed configuration. It is noted again the phrase "wherein the outer tube is axially retractable to remove the constraint on the embolus removal apparatus such that the removal apparatus automatically expands from the collapsed configuration to a deployed configuration" (a functional limitation): thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. (See MPEP 2111.04 and MPEP 2112.01). It is noted that the procedure of

figures 16,17 of Ressemann would allow the removal element 16 to be operable resulting in a contraction upon an axial retraction of the catheter shaft 188. If there is a contraction to occur then it would have some sort of automatically expansion motion upon the axial retraction of the shaft 188.

Applicant's argument with regard to that Resseman fails to teach a plurality of resilient members have proximal ends freely slid able over the inner tube". It is noted again the phrase "a plurality of resilient members have proximal ends freely slid able over the inner tub" (a functional limitation): thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. (See MPEP 2111.04 and MPEP 2112.01). In fact, the procedure in fig. 14 of Resseman teaches the proximal ends 202 of the removal element 16 are inherently freely slid able over the inner tube 94. As broadly as claimed, Resseman meets the limitations of the reected claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN